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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,827	01/27/1999	JOHN S. HENDRICKS	5260	7009

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EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,827

Applicant(s)

HENDRICKS ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 32-62 and 64-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 041299.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 32-62 and 64-106 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/23/04. Applicant argues that the subject matter of claims 1-106 is related to the extent that a single search would encompass the subject matter of all the claims. The Examiner refers Applicant to the previous Office Action, which details the divergent subject matter and subsequent search areas that each group of claims corresponds to. Because the four claimed inventions are distinct and belong to different classifications, additional burden would subsequently be imposed on the Examiner in order to properly and thoroughly search and examine each group of claims. For this reason, the Examiner believes the restriction requirement as set forth in the previous Office Action is proper.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: Figure 16b, 912. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 6a, 270'; Figure 6c, 619; Figure 14a, 742; Figure 13, 886; Figure 14g, 880'; Figures 14j-14m, 864'; Figure

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14s, 851; Figure 14t, 853. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 8, 10-13, 18-19, 22, 24, 26-29 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,093,718 to Hoarty et al.

Regarding Claim 1, Hoarty discloses a system for transmitting and receiving text (Col. 6, Lines 36-39) and displaying an indication of the text (Col. 11, Lines 11-23), wherein the text is transmitting in an electronic signal (Col. 8, Lines 18-54), the system comprising a processor (See Figure 2, head-end computer 8) that produces an electronic signal containing a representation of the textual data as stated above, a transmitter

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connected to the processor (Col. 8, Lines 30-34) and a connector (home interface controller, See Figure 1, 16 and Col. 5, Lines 24-30) that receives the electronic signal (Col. 5, Lines 31-34 and Col. 8, Lines 7-9). Further disclosed is a TV (See Figure 3, 38). This reads on the claimed display, connected to the connector (home interface controller) that displays a particular library menu (Col. 13, Lines 17-20) relating to the textual data and based upon a user-entered selection (Col. 11, Lines 11-23).

Regarding Claim 2, Hoarty discloses a system as stated above in Claim 1, wherein the processor produces the electronic signal as a video formatted composite signal (Col. 8, Lines 30-46).

Regarding Claim 8, Hoarty discloses a system as stated above in Claim 1, wherein the connector (home interface terminal) comprises a set top terminal (Col. 5, Lines 24-27) with a memory (See Figure 8, 80). It is inherent in such a GUI-based system with on-screen text and icons (Col. 7, Lines 1-6) that data must be stored memory. Further disclosed is that the display comprises a television (See Figure 9, 38).

Regarding Claim 10, Hoarty discloses a system as stated above in Claim 1, wherein the head-end system transmits digital data using a modulated carrier (Col. 8, Lines 35-42) on an analog television channel. This reads on the claimed processor (head end computer) comprising an encoder.

Regarding Claims 11 and 12, Hoarty discloses a system as stated above in Claim 1, wherein the head-end broadcasts data over a cable TV system (Col. 8, Lines 43-46). This reads on the claimed transmitter module comprising a broadcast television transmitter.

Regarding Claim 13, Hoarty discloses a system as stated above in Claim 12, wherein the connector (home interface controller) is connected to the cable television network (See Figure 9). This reads on the claimed connector comprising a cable connector. The connector receives interactive data on a dedicated television channel (Col. 13, Lines 1-25). This reads on the claimed extracting textual data from the video formatted composite signal (CATV signal).

Regarding Claim 18, see Claims 1 and 10 above.

Regarding Claim 19, see Claim 2 above.

Regarding Claim 22, Hoarty discloses a method as stated above in Claim 18, further comprising receiving an indication of a selected portion of the textual data identified by the menu and displaying the selected portion of the textual data (Col. 7, Lines 1-6).

Regarding Claim 24, Hoarty discloses a method as stated above in Claim 18, wherein the set top terminal receives a video signal from the CATV network (See Figure 3) as stated above. Further disclosed is that the set top terminal has a memory (See Figure 8, 80) for storage of selected textual data, as stated above. Also, the set top terminal uses a television (See Figure 3, 38) to display the menu, as stated above.

Regarding Claims 26 and 27, see Claims 10 and 11 above, respectively.

Regarding Claim 28, Hoarty discloses a method as stated above in Claim 19, wherein the head-end transmits the text data in an RF carrier using modulation (Col. 8, Lines 35-46) in a separate channel space between physical TV channels. This reads on the claimed sending textual data without any video. The textual data is received by a

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node, which then supplies the data via a dedicated full-bandwidth video channel to the user (Col. 13, Lines 1-10 and Lines 21-58). This reads on the claimed using the textual data to fill an entire channel of video, and using a cable television transmitter to send the textual data.

Regarding Claim 29, see Claim 13 above.

Regarding Claim 63, see Claim 1 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of U.S. Patent No. 5,210,611 to Yee et al.

Regarding Claim 3, Hoarty discloses a system as stated above in Claim 1. What is not disclosed, however, is that the processor produces the electronic signal as a signal to be transmitted over a telephone system. Yee discloses a system for transmitting and receiving teletext (Col. 9, Lines 55-58) for use on a television (Col. 6, Lines 39-43). Yee further discloses that data may be transmitted over telephone lines and received at the user's terminal via a modem (Col. 9, Lines 63-67). Yee is evidence that ordinary workers in the art would appreciate the ability to use an electronic signal transmitted over a telephone signal in a television-based text transmission system. Therefore, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty with the telephone transmission of data of Yee in order to allow users to receive data from other private sources as taught by Yee (Col. 9, Lines 63-67).

8. Claims 4-5, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of U.S. Patent No. 5,632,022 to Warren et al.

Regarding Claim 4, Hoarty discloses a system as stated above in Claim 1. What is not disclosed, however, is that the display displays an electronic representation of books on a book shelf, related to the textual data. Warren discloses a graphical user interface (Col. 6, Lines 19-22) that uses a bookshelf metaphor (See Figure 1, Col. 6, Lines 1-10 and 36-43) to browse and query (Col. 7, Lines 29-32) information. Warren is evidence that one of ordinary skill in the art would appreciate the ability to represent data as books on a bookshelf. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty with the bookshelf metaphor of Warren in order to present users with an immediately familiar method of accessing data as disclosed by Warren (Col. 6, Lines 39-67).

Regarding Claim 5, Hoarty discloses a system as stated above in Claim 1. Further, Hoarty in view of Warren disclose a system as stated above in Claim 4. Warren further discloses formatting the menu according to category (See Figure 1 and Col. 7, Line 48-64).

Regarding Claims 20 and 21, see Claims 4 and 5 above, respectively.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of U.S. Patent No. 4,361,848 to Poignet et al.

Regarding Claim 6, Hoarty discloses a system as stated above in Claim 1, wherein the set top comprises a microprocessor (See Figure 8, 80) that receives an indication of a selected portion of the textual data identified by the menu (Col. 10, Lines 10-14), and wherein the display displays the selected portion of the textual data (Col. 7, Lines 1-6). What is not disclosed, however, is that the display comprises the microprocessor that receives the indication. Poignet discloses a teletext system for broadcasting pages to a television receiver wherein the reception terminal may be integrated with the television receiver (Col. 4, Lines 51-60). This reads on the claimed display comprising a microprocessor. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty with the set top integrating with the television of Poignet in order to reduce the cost and complexity of the user's systems as well as the required wiring/setup.

10. Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al.

Regarding Claim 7, Hoarty discloses a system as stated above in Claim 1. What is not disclosed, however, is that the display displays a default menu. Official Notice is hereby taken that it is well known in the art to display a default menu. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to modify the system of Hoarty with the default menu of the well-known prior art in order to provide a consistent entry point from which the user may begin to operate the graphical user interface.

Regarding Claim 23, see Claim 7 above.

11. Claims 9, 14-17, 25 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of U.S. Patent No. 5,475,399 to Borsuk.

Regarding Claim 9, Hoarty discloses a system as stated above in Claim 1. What is not disclosed, however, is that the display comprises a portable, hand-held viewer.

Borsuk discloses a hand-held portable reading unit (See Figure 1) that is connected to a computer and modem (See Figure 5 and Col. 6, Lines 1-20) for reading text (Col. 4, Lines 35-41 and Col. 5, Lines 57-67). Borsuk is evidence that ordinary workers in the art would appreciate the ability to use a portable device to read textual data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Hoarty with the portable reader of Borsuk in order to allow a user to read content wherever or whenever they choose (Col. 1, Lines 23-29).

Regarding Claim 14, Hoarty discloses a system as stated above in Claim 1.

Hoarty in view of Borsuk further disclose a system as stated above in Claim 9. Borsuk further discloses a library unit, such as a computer (See Figure 5), connected to a connector such as a modem (Col. 6, Lines 15-17), for processing textual data. The PC acts as a mass storage database (Col. 6, Lines 1-2) that receives data from remote locations as stated above. This reads on the claimed digital logic for screening textual

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data and a memory for storing the data. Further, a viewer (See Figure 1) interfaces with the library unit electronically (See Figure 5 and Col. 6, Lines 4-9), the viewer displaying the textual data as text (Col. 5, Lines 57-67).

Regarding Claim 15, Hoarty in view of Borsuk disclose a system as stated above in Claim 14. Borsuk discloses that a PC (library unit) stores text files (Col. 6, Lines 15-17) for transmission to a portable reader as stated above. Further disclosed is that the PC contains a screen and a user interface, such as a keyboard (See Figure 5 and Col. 6, Line 10). It would be obvious to one having ordinary skill in the art at the time the invention was made that a computer with a display that stores text files locally would be able to display the stored text files with a viewer such as a text viewing program. This reads on the claimed library unit (computer) and viewer (viewing program) being contained within a common housing.

Regarding Claim 16, Hoarty in view of Borsuk disclose a system as stated above in Claim 14. Borsuk further discloses that the portable viewer has a memory (See Figure 2, RAM 44) for storing text data (Col. 4, Lines 35-39) received from the library unit (Col. 6, Lines 1-9). Further disclosed is a microprocessor (40) connected to the second memory (See Figure 2) for controlling the functions of the viewer. Also disclosed is a digital display circuit (50) for creating displays (Col. 4, Lines 15-18) and a liquid crystal display (Col. 3, Line 49) connected to the digital display circuitry (See Figure 2, 8) for displaying text.

Regarding Claim 17, Hoarty in view of Borsuk disclose a system as stated above in Claim 14. Borsuk further discloses that the portable viewer comprises a storage media

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device insert port in which an EEPROM memory device is received (Col. 3, Lines 57-62). This reads on the claimed second memory comprising a removable electronic card memory.

Regarding Claim 25, see Claim 9 above.

Regarding Claims 30 and 31, see Claims 14 and 15 above, respectively.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 5,239,665 to Tsuchiya discloses an electronic book with a portable viewer and a library unit designed to obtain books from a telephone network or a vending machine using electronic cards.
- b. U.S. Patent No. 6,243,071 to Shwartz et al. discloses an electronic book on a hand held portable viewer with a GUI, LCD screen, removable storage and menu of books.
- c. U.S. Patent No. 5,534,888 to Leiby et al. discloses an electronic book in a portable housing that may be coupled to a telephone line, personal computer or wireless network and uses an LCD display with removable media.
- d. U.S. Patent No. 6,462,729 to Morita discloses a portable display device with a separate library unit and a search function for searching local storage or remote CD storage.
- e. U.S. Patent No. 4,639,225 to Washizuka discloses a portable display device with a removable memory card for storing display information such as novels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd

January 13, 2005


CHRIS GRANT
PRIMARY EXAMINER